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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,344	10/24/2000	Seishi Ejiri	1232-4303US2	9182
27123	7590	01/10/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			MANIWANG, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,344

Applicant(s)

EJIRI, SEISHI

Examiner

Joseph R Maniwang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/28/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 38-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed subject matter is directed towards a computer-readable program to be used by a data processing apparatus, which appears to be nothing more than software not tangibly embodied on a computer-readable medium.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 18-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon et al. (U.S. Pat. No. 5,459,584), hereinafter referred to as Gordon.
5. Regarding claims 18, 28, and 38, Gordon disclosed a method and system including store and forward facilities (SAFF) adapted to receive fax data for a plurality of

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receivers (see column 6, lines 31-37). The SAFF included the ability to notify the receivers of an incoming fax (see column 4, lines 60-63). The SAFF could also transmit information representing a result of the fax transmission to the transmission side from which the fax was sent (see column 3, lines 18-22; column 5, lines 58-64; column 8, lines 54-59; column 8, line 66 through column 9, line 12; column 15, lines 16-25; column 20, lines 18-30). Gordon disclosed the provision for determining whether a predetermined time has been reached (see column 9, lines 13-40). Gordon further disclosed two modes for transmitting notification information that could be programmed (i.e., selected) into the SAFF. In the first mode, the SAFF transmitted the information regardless of the predetermined time (see column 10, lines 27-34). In the second mode, the SAFF transmitted the information collectively after a predetermined time as claimed (see column 10, lines 10-16; column 12, lines 2-4).

6. Regarding claims 19, 29, and 39, in the case where notification information was sent regardless of a predetermined time (i.e., in response to a request from an originator), Gordon disclosed that this type of transmission was made regarding a single message designated by a Message Code, and at one communication, in which the sender dialed a Service Number to submit an inquiry (see column 3, lines 29-36; column 10, lines 27-34).

7. Regarding claims 20, 30, and 40, Gordon disclosed notifying the receivers designated by the transmission side that fax data had been received (see column 4, lines 60-63).

8. Regarding claims 21, 31, and 41, the notification sent to the receivers was a state where the receiver could obtain the fax as claimed (see column 4, lines 56-67; column 14, line 1 through column 15, line 15).

9. Regarding claims 22, 32, and 42, Gordon disclosed a method and system including store and forward facilities (SAFF) adapted to receive fax data for a plurality of receivers (see column 6, lines 31-37). The SAFF included the ability to notify the receivers of an incoming fax (see column 4, lines 60-63). The SAFF could also transmit information representing a result of the fax transmission to the transmission side from which the fax was sent (see column 3, lines 18-22; column 5, lines 58-64; column 8, lines 54-59; column 8, line 66 through column 9, line 12; column 15, lines 16-25; column 20, lines 18-30). Gordon further disclosed two modes for transmitting notification information that could be programmed (i.e., set) into the SAFF. In the first mode, the SAFF transmitted the information in response to a request from the transmission side from which the fax was transmitted (see column 10, lines 14, 27-34). Alternatively, in the second mode, the SAFF transmitted the information automatically after a period of time and without request from the transmission side (see column 9, lines 30-40; column 10, lines 10-16).

10. Regarding claims 23, 33, and 43, Gordon further disclosed two modes for transmitting notification information that could be programmed (i.e., set) into the SAFF, the SAFF transmitting in accordance with the mode set as claimed (see column 10, lines 10-16, 27-34; column 12, lines 2-4).

11. Regarding claims 24, 34, and 44, Gordon disclosed that one type of transmission was made regarding a single message designated by a Message Code, and at one communication, in which the sender dialed a Service Number to submit an inquiry (see column 3, lines 29-36; column 10, lines 27-34), thus disclosing transmitting information one by one by plural-time communications, and further disclosed collectively transmitting information in a single fax document, thus disclosing transmitting information by one-time communications as claimed (see column 10, lines 10-16; column 12, lines 2-4).

12. Regarding claims 25, 35, and 45, Gordon disclosed generating a call to the destination fax based on information included in fax data received by the SAFF (see column 11, lines 18-27).

13. Regarding claims 26, 36, and 46, Gordon disclosed notifying the receivers designated by the transmission side that fax data had been received (see column 4, lines 60-63).

14. Regarding claims 27, 37, and 47, the notification sent to the receivers was a state where the receiver could obtain the fax as claimed (see column 4, lines 56-67; column 14, line 1 through column 15, line 15).

Response to Arguments

15. Applicant's arguments with respect to claims 18-47 have been considered but are moot in view of the new ground(s) of rejection. Examiner submits that the claimed

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limitations are taught by Gordon et al. (U.S. Pat. No. 5,459,584) as recited in the above rejection under 35 U.S.C. 102(e).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Von Meister (U.S. Pat. No. 5,452,099) disclosed a method and system for receiving and sending fax documents including notification to a recipient and sender.

Bloomfield (U.S. Pat. No. 5,404,231) disclosed a fax store and forward facility with delivery confirmation.

Gordon et al. (U.S. Pat. No. 4,994,926) disclosed a method and system for fax transmission using store and forward facilities, including status notification.

Marshall (U.S. Pat. No. 6,396,597) disclosed a computer network-based fax reception system that notified a recipient of a received document.

Amberg et al. (U.S. Pat. No. 5,410,416) disclosed a fax gateway.

Reifman et al. (U.S. Pat. No. 5,539,530) disclosed a fax machine able to print confirmation reports.


Teramura et al. ("Experimental Facsimile Communication System on Packet Switched Data Network", IEEE Transactions on Communications, Volume 29, Issue 12, Dec 1981) disclosed a fax communication system that provided store-and-forward facilities capable of notifying a sender of the status of a sent message.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A Cuchlinski can be reached on (571) 272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM


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